

VIA FACSIMILE: (703) 308- 4426

100725-24 / Kreisler 1098-KGB
012142us/JH/ml**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANTS : GERD HOBOM ET AL.
SERIAL NO. : 09/914,658
FILED : August 31, 2001
FOR : STABLE RECOMBINANT INFLUENZA VIRUSES FREE
OF HELPER VIRUSES
ART UNIT : 1648
EXAMINER : S. Chen

November 3, 2003

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450**RESPONSE TO RESTRICTION REQUIREMENT**

SIR:

In response to the Office Action dated October 2, 2003, Applicants hereby elect with traverse to prosecute the invention of Group I, comprising claims 1-22, 24-26, and 28-30, drawn to a virus, a method of using the virus, and a method of making the virus.

Remarks begin at page 3 of this paper.

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REMARKS

Applicants reserve the right to prosecute the subject matter of the non-elected claims in a divisional application, if such subject matter is not ultimately granted here.

Regarding the traversal, the basis for the Examiner's restriction is under PCT Rule 13.1 for lack of Unity of Invention. The Examiner alleges that Groups I and II do not form a single inventive concept within Rule 13.2, and cites 37 CFR §1.475(d) in support of her contention. However, nothing in 37 CFR §1.475(d) says the second and subsequent recited methods and/or uses cannot share unity of invention with the main invention.

According to PCT Administrative Rules (Annex B, Part I) "unity of invention exists only when there is a special technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features." The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.

In the instant case, Applicants submit that the special technical feature shared by all of the claims in Groups I and II is the recombinant influenza virus. Because the claims are directed to a recombinant influenza virus, a method of making the virus, a method of using the virus, and a method of producing proteins using the virus, they all share this special technical feature and thus unity of invention exists. Accordingly, Applicants submit the restriction is


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improper and request the restriction requirement to be withdrawn.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Response to Restriction Requirement (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: November 3, 2003

By 
David D. Kim